Morris, Craig

From: David Bollier (b)(6)
Sent: Monday, February 14, 2011 11:14 AM
To: TMFeedback
Subject: Small Business Study
Attachments: Part II. Trademarking Public Life; david.vcf

To the US PTO:

The following comments are made pursuant to its study of "litigation tactics, especially those involving an attempt to enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to the trademark owner," a study mandated by the Trademark Technical and Conforming Amendment Act of 2010 became effective on March 17, 2010. Pub. L. No. 111-146, 124 Stat. 66 (2010).

Below, I respond to the queries (by number) that the US PTO request for comments enumerated:

Query #1. My involvement with trademark law and its enforcement.
I write as an author of a book that documented a wide variety of abuses in trademark litigation. "Brand Name Bullies: The Quest to Own and Control Culture" (John Wiley & Sons, 2005) focused on corporate and litigation "bullying" against small businesses and individuals through the use of copyright and trademark law. Part Two of my book, "Trademarking Public Life" looked at this phenomenon in a focused way.

Query #2. Firsthand Knowledge of trademark litigation tactics.
My book is now six years old, so the stories therein are not within the five year time-frame requested by your notice. However, my book documents that trademark litigation abuse goes far back into the past, and if anything, has accelerated over the past ten years. Chapter 4 of is called "Trademark Owners Whine, "No Making Fun of Me!" Chapter 5 is entitled "The Corporate Privatization of Words," and Chapter 6 is called "Property Rights in Public Image." I have attached these chapters (in typescript) for your consideration.

(Since I just learned of the US PTO notice, I do not have time to mail you a hard copy of my book. The following page numbers refer to book pages, not the manuscript pages. I would be happy to provide you with a copy of my book, Brand Name Bullies, if you will consider it as part of the record. In the meantime, I attach Part II -- Chapters 3, 4 and 5 -- of my book for your consideration.)

Queries #3-#7
Trademark bullying is quite common and takes many forms. I describe, for example, the extensive history of Mattel and its hyper-aggressive "defense" of its Barbie (and affiliated) trademarks (pp. 84-93). Perhaps the most egregious story is Mattel's litigation against photographer Tom Forsythe, who had produced a photo exhibit of Barbie in various unflattering or sexual poses. Even though the exhibit was a very small, obscure affair, the photographer's law firm ended up spending at least $1.6 million to defend Forsythe up to the 9th Circuit Court of Appeals. Forsythe was lucky because he enjoyed a pro bono defense by the San Frfancisco law firm Howard Irce Nemerovski Canady Falk & Rabkin. Needless to say, most targets of trademark bullying have no such luxury, perhaps because there is not a clear set of facts that might easily prevail in court or establish a new court precedent (as Forsythe's case did).

The Disney Company's legal threats against parodies and other unauthorized uses of Disney characters are also legendary, especially in cases involving Mickey Mouse (pp. 107-109). Cease-and-desist letters aimed at people who do web parodies are also common (pp. 93-97), with the predictable chilling effects on free speech and cultural expression. This problem extends to all sorts of clothing, including t-shirts, some of whose messages or designs are clearly intended as a public commentary or parody and therefore ought to be fully protected by the First Amendment.

McDonald's has gone after all sorts of small businesses who have dared to use the Irish/Scottish prefix "Mc" in their names, such as "McSushi," "McVegan," and "McSleep," among many others. The Village Voice went after the Cape Cod Voice for supposedly infringing upon its trademarked word "Voice." The U.S. Olympic Committee has gone after the "Gay Olympics" for supposedly infringing its trademark rights in "Olympics." Fox News once went after Al Franken and his publisher, Penguin/Dutton, for using the term "fair and balanced" in the subtitle of his book, "Lies and the Lying Liars Who Tell Them." It was a totally frivolous legal threat that was withstood only because Franken had a large, reputable publisher. Smaller ones risk going bankrupt if they try to resist a large trademark bully, as when Mattel threatened the small Seattle-based publisher, Seal Press, for its 1998 collection of essays about eating disorders, "Adios, Barbie," edited by Ophira Edut. After pressure from Mattel, the book was later re-issued with a new title, "Body Outlaws."

So, in regard to your query #6, yes, trademark owners are using "their trademark rights to harass and intimidate another business beyond what the law might be reasonably interpreted to allow." It is a very significant problem.

Query #8

Re query #8, the USPTO has an affirmative responsibility to discourage or prevent aggressive trademark litigation tactics. The USPTO represents the American people, not trademark owners alone. Yet too often trademark owners are allows to overstate the scope of their trademark rights with impunity, often at the expense of small businesses, individuals and their First Amendment rights or legitimate competitive interests.

As I state in one section of my book, (p. 119), trademark owners use the law for "Patrolling the Boundaries of Mental Association." Just because MasterCard uses the word "Priceless" in its stylized advertising campaigns does not mean it should allowed to prevent a candidate for public office from using the word "Priceless" and a parody of the MasterCard ads in his TV ads. The trademark "dilution" and "tarnishment" standards are too often abuses to claim monopolies on public meaning and image, which is an unwarranted extension of trademark rights in a free, democratic culture.

Query #9

Re query #9, yes, the U.S. courts "have a responsibility to do something to discourage or prevent aggressive trademark litigation tactics." Given the extent of trademark bullying, the courts should be much more aggressive in identifying and punishing trademark bullies so that such behavior does not continue. Although there are a number of cases in which the courts have drawn a line, saying that trademark claims have gone too far, this is often an inadequate protection for small businesses and individuals who often do not have the money to hire expensive legal teams to vindicate their rights. There is typically a mismatch of legal resources that favors trademark owners. This in effect enables them to expand the law as much "as they get away with." Any remedial policies must take account of this structural mismatch in access to legal resources and thus the courts.

To prevent their relentless "testing of the limits" of trademark law, which under the dilution and tarnishment standards have extended wildly and unpredictably, the courts need to set some clearer, bright-line standards to protect normal marketplace and cultural uses of common words, images and phrases that may also happen to be trademarked. The courts must also establish significant penalties for companies who abuse trademark law. Currently there are few risks or penalties for companies that simply instruct their attorneys to send out threatening cease-and-desist letters without any serious consideration given to the legal merits of their claims. In effect, the entire legal system, by "looking the other way," conspires in this bullying.

It is an affront to a democratic people to have ordinary words be "owned" by companies, such that citizens often fear legal threats simply for using ordinary words like "Barbie" and "Voice" (as a newspaper name) and the phoneme "zilla" (which the trademark owner of "Godzilla" has attempted to proscribe). Trademark law was never meant to supplant and supersede democratic culture.

Congress, too, has a responsibility to offer the courts greater clarity and clear statutory guidance on these questions. But given the financial influence of large trademark holders on the elections of members of Congress, this may be a quixotic hope. Still, it is clear that trademark law is frequently abused to silence critics of a product or company, or to suppress legitimate marketplace competition, or simply to suppress ordinary, everyday cultural uses of a word, image or mental idea.

There will always be close judgment calls in this area, but that is all the more reason for Congress, the courts and the USPTO to try to establish more reliable, predictable and fair standards for trademark claims, so that ordinary citizens and small businesses will not be disenfranchised from using the ordinary words and familiar images of our culture. Penalties for abuse of the law must be increased to discourse such bullying.

Respect for the integrity of trademark law is declining as extreme, abusive cases of trademark litigation proliferate. Without this respect and a perceived fairness of the law, citizens will come to regard trademark law as an open-ended, illegitimate tool of large market players to suppress normal cultural expression. They will see trademark law as privileging the commercial concerns of big companies over the basic constitutional rights and cultural traditions of a free people. "Branding" concerns should not supersede the First Amendment.

I therefore urge the USPTO to propose policy changes that will adequately protect small businesses and individual citizens from the unwarranted abuses of trademark litigation and threats.

Sincerely,
David Bollier

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